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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,699

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Mark L. Posey

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2989

29089

7590

04/01/2009

HUNTSMAN PETROCHEMICAL CORPORATION
LEGAL DEPARTMENT
10003 WOODLOCH FOREST DRIVE
THE WOODLANDS, TX 77380

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1796

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/563,699	Applicant(s) POSEY ET AL.	
	Examiner Rabon Sergent	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/18/2008</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to define the language, "substantial absence". It cannot be determined what amount of chain extender is permitted by the language or how "substantial absence" differs from "absence".

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the use of "may ... be" within the definition of "b" and "c" within claims 1 and 11 renders the claims indefinite, because it cannot be determined to what extent the language denoted by "may ... be" is a definitive limitation or requirement.

Secondly, within claims 1 and 11, "a" has been defined within the description of embodiment iii); therefore, it is unclear if the definition is operative only for this embodiment or for all embodiments. If it is operative only for embodiment iii), then the variable lacks definition for the remaining embodiments.

Thirdly, the language, "said one or more polyamino compounds", lacks antecedent basis; the language is not necessarily equivalent to "one or more polyether polyamino compounds".

Fourthly, with respect to claims 1 and 11, given that the variables, "a" and "q" may be zero, the formula may be devoid of ether groups; however, applicants refer to the compounds as

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polyether compounds. It is unclear how to reconcile the language with the formulas, in that it is unclear that the formulas must represent polyethers.

Fifthly, similarly to the issue above, it is noted that the formulas for the polyamines within claims 1 and 11 may possess solely primary amine groups; therefore, it is unclear to what extent the formulas must contain secondary amine groups.

Sixthly, with respect to claim 3, it cannot be determined what amount of chain extender is permitted by the language, “substantial absence”, or how “substantial absence” differs from “absence”.

Seventhly, with respect to claim 14, the language, “pigments in its polymer backbone”, is not understood. It is unclear what is meant by “its polymer backbone”.

Lastly, with respect to claims 19 and 20, it is not seen how a prepolymer having the claimed properties can depend from the polyurea of claim 11, which is required to possess the claimed tear strength properties.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

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USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 4-18 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 7,078,475. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to the production of a polyurea from the reaction of polyisocyanate and polyamines, wherein the polyamines of the patent encompass the secondary amines of the instant claims.

5. Claims 1 and 4-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 11/375,924. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to the production of a polyurea from the

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reaction of polyisocyanate and polyamines, wherein the polyamines of the copending application encompass the secondary amines of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1 and 4-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/365,726. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims is drawn to the production of a polyurea from the reaction of polyisocyanate and polyamines, wherein the polyamines of the copending application are met by secondary amine formula of the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1 and 4-18 are directed to an invention not patentably distinct from claims 1-18 of commonly assigned 11/375,924 for the reasons set forth within paragraph 5.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300).

Commonly assigned application 11/375,924, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that

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the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

8. The examiner has reviewed provisional application 60/485,129, from which applicants claim priority; however, the disclosure within 60/485,129 is insufficient to support the full scope of the claimed subject matter under the provisions of 35 USC 112, first paragraph. Accordingly, applicants cannot rely upon the filing date of the provisional application.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 and 4-18 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No. 11/375,924 which has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if published under 35 U.S.C. 122(b) or patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future publication or patenting of the copending application. The copending application discloses

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the production of polyureas by reacting polyisocyanate with polyoxyalkylene polyamines, wherein the structural formulas of the polyoxyalkylene polyamines allow for the presence of secondary amine groups.

This provisional rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131. This rejection may not be overcome by the filing of a terminal disclaimer. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

11. Claims 1 and 4-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Primeaux, II et al. (‘677 or ‘736 or ‘755 or ‘684).

Each of the references discloses the reaction of polyisocyanates with secondary amine group containing polyoxyalkylene polyamines that have structures that correspond to those instantly claimed. The references further disclose the use of chain extenders in the production of the polyureas. See column 4, line 53 through column 5, line 37 within Primeaux, II et al. (‘677). See column 7, line 32 through column 8, line 5 within Primeaux, II et al. (‘736). See column 4, line 41 through column 4, line 14 within Primeaux, II et al. (‘755). See column 7, line 44 through column 8, line 17 within Primeaux, II et al. (‘684). See column 4, line 53 through column 5, line 37 within Primeaux, II et al. (‘677).

12. Claims 1, 2, and 4-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hinz et al. (‘852) or Becker et al. (‘487) or WO 02/102869 A1.

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Each of the references discloses the reaction of polyisocyanates with secondary amine group containing polyoxyalkylene polyamines that have structures that correspond to those instantly claimed. The references further disclose the use of chain extenders in the production of the polyureas. Lastly, with respect to claim 2, the references disclose index ratios such that an excess of isocyanate reactive groups will be present relative to the isocyanate functional groups. See column 6, lines 50+; column 7; and column 10, lines 22-33 within Hinz et al. See column 9, lines 58+; column 10; and column 14, lines 3-12 within Becker et al. See abstract and pages 5-9 and 14 within WO 02/102869. The formulas set forth within these pages WO 02/102869 clearly encompass secondary amine groups.

13. Claims 1 and 3-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Grigsby, Jr. et al. ('814).

Patentees disclose the reaction of polyisocyanate with polyoxyalkylene polyamine, wherein the polyoxyalkylene is present in less than the stoichiometric amount. Furthermore, the reference discloses that the polyoxyalkylene polyamines may be secondary amine terminated. See abstract; column 2, lines 15+; column 3; and column 4, lines 15-28. Given the description of the polyoxyalkylene polyamines, the position is taken that they correspond to applicants' claimed formulas. Furthermore, the position is taken, in view of the disclosure that the polyoxyalkylene polyamines are reacted in less than stoichiometric amounts, that prepolymers that correspond to those of claims 19 and 20 are encompassed by the reference.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

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/Rabon Sergent/
Primary Examiner, Art Unit 1796